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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,973	09/24/2003	Takashi Yano	240117US-2 CONT	1462
22850	7590	11/10/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.			ALI, MOHAMMAD	
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ALEXANDRIA, VA 22314			PAPER NUMBER	

2167

DATE MAILED: 11/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/668,973

Applicant(s)

YANO ET AL.

Examiner

Mohammad Ali

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 2-31 is/are rejected.
- 7) ☒ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10-13-04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. The application has been examined. Claims 2-31 are pending in this

Office Action.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 2, 17, 30, and 31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 18, 26, and 56 respectively of U.S. Patent No. 6,658,408. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are substantially similar in scope and they use the same limitations, using varying terminology. Please see explanation below.

Certain limitations including 'configured to display', found in claims 1-5 and 11 in this instant application not found in USP 6,658,408. It would be obvious to a person of ordinary skill in the art at the time the invention was made to exclude the terms 'configured to display' because the remaining elements would

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have performed the same function as before. "Omission of element and its function and its function in combination is obvious expedient if the remaining elements perform the same function as before" See In re Karlson (CCPA) 136 USPQ 184, decide Jan 16, 1963, Appl. No. 6857, U.S. Court of Customs and Patent Appeals.

This is a obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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4. Claims 2-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robert J. Kamper ('kamper', hereinafter), US Patent 5,982,370 in view of Evans et al., ('Evans', hereinafter), US Patent 5,926,808.

With respect to claim 2,

Kamper discloses a method of managing information (see Abstract, lines 4-9), comprising:

identifying a word of an image as a keyword (see col. 3, lines 16-23, Kamper);
determining a search result corresponding to the keyword (see col. 3, lines 35-43, Kamper);
displaying information corresponding to the search result (see col. 3, lines 42-43, Kamper); and
displaying additional information corresponding to a selection of a portion of the displayed information (see col. 3, lines 34-37).

Kamper does not explicitly indicate the claimed "keyword displayed image".

Evans discloses the claimed keyword displayed image (Hyperlinks operate on a page image shown to a database user. A phrase or text section on the page image will be highlighted. When a user selects this phrase clicking on the mouse, the user immediately shown the related text from another document, see col. 1, lines 39-43, Evans).

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It would have been obvious to one ordinary skill in the data processing art, at the time of the present invention to have combined the teachings of the cited references because keyword displayed image of Evans's teachings would have allowed Kamper's system to select a phrase or text from the page image by clicking with a mouse will be able immediately shown related text from another document as suggested by Evans, see col. 1, lines 39-43). Keyword displayed image as taught by Evans improves to display portions of text from multiple documents over multiple databases related to a search query (see col. 2, lines 36-37 et seq, Evans).

As to claim 3,

Kamper teaches wherein the image is displayed on a display unit (col. 10, lines 26-37).

As to claim 4,

Kamper teaches wherein the information corresponding to the search result is displayed on a display unit (col. 10, lines 26-37).

As to claim 5,

Kamper teaches wherein the step of displaying additional information is performed without altering a file corresponding to the image (col. 10, lines 26-37 et seq).

As to claim 6,

Kamper teaches selecting, after the step of displaying information and before the step of displaying additional information, the portion of the displayed information (col. 10, lines 26-37).

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As to claim 7,

Kamper teaches wherein the determining step comprises: determining the search result using a search engine accessible by a browser (col. 10, lines 26-37).

As to claim 8,

Kamper teaches wherein the step of identifying a word is performed using a pointing device (col. 10, lines 26-37).

As to claim 9,

Kamper teaches wherein the step of identifying a word is performed using a cursor position (col. 10, lines 3-4).

As to claim 10,

Kamper teaches displaying, on a display unit, a pop-up menu prepared based on the search result (col. 10, lines 26-37).

As to claim 11,

Kamper teaches wherein the identified word is a non-linked word (col. 10, lines 26-37).

As to claim 12,

Kamper teaches wherein, when a file is displayed on a display unit, a word from the file is identified as the keyword specified by a cursor on the display unit (col. 10, lines 3-4).

As to claim 13,

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Kamper teaches displaying, on a display unit, in a space adjacent to the keyword, a menu comprising menu items for specifying search criteria for a search engine (see col. 3, lines 16-23, Kamper); and

specifying the menu item by a cursor, wherein the keyword and the menu items specified are input into the search engine (col. 10, lines 3-4).

As to claim 14,

Kamper teaches wherein the menu is for specifying at least one search database (see col. 3, lines 16-23, Kamper).

As to claim 15,

Kamper teaches displaying, on a display unit, in a space adjacent to the keyword, a menu for specifying output criteria of the search result (see col. 3, lines 16-23, Kamper).

As to claim 16,

Kamper teaches wherein the menu is for specifying where to output the search result (see col. 3, lines 16-23, Kamper).

With respect to claim 17,

Kamper discloses an information management device (see Abstract, lines 4-9), comprising:

a display unit configured to display an image (see col. 3, lines 16-23, Kamper);

an identification unit configured to identify a word displayed in the image to be a keyword (see col. 3, lines 16-23, Kamper); and

a search unit configured to input the keyword and to output a search result

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corresponding to the keyword (see col. 3, lines 35-43, Kamper), wherein the display unit is configured to obtain the search result corresponding to the keyword from the search unit (see col. 3, lines 42-43, Kamper), to display information corresponding to the search result, and to display additional information corresponding to a selection of a portion of the displayed information (see col. 3, lines 34-37).

Kamper does not explicitly indicate the claimed "word displayed in an image".

Evans discloses the claimed word displayed in an image (Hyperlinks operate on a page image shown to a database user. A phrase or text section on the page image will be highlighted. When a user selects this phrase clicking on the mouse, the user immediately shown the related text from another document, see col. 1, lines 39-43, Evans).

It would have been obvious to one ordinary skill in the data processing art, at the time of the present invention to have combined the teachings of the cited references because word displayed in an image of Evans's teachings would have allowed Kamper's system to select a phrase or text from the page image by clicking with a mouse will be able immediately shown related text from another document as suggested by Evans, see col. 1, lines 39-43). Word displayed in an image as taught by Evans improves to display portions of text from multiple documents over multiple databases related to a search query (see col. 2, lines 36-37 et seq, Evans).

As to claim 18,

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Kamper teaches a selection unit configured to receive an input from a user who selects a portion of the displayed information; and at least one database for storing therein at least one file (see col. 3, lines 16-23, Kamper).

As to claim 19,

Kamper teaches wherein said search unit is a search engine accessible by a browser (see col. 3, lines 16-23 et seq, Kamper).

As to claim 20,

Kamper teaches wherein the identification unit is configured to identify the word using a pointing device (see col. 3, lines 38-43, kamper).

As to claim 21,

Kamper teaches wherein the identification unit is configured to identify the word using a cursor position (see col. 3, lines 38-43, kamper).

As to claim 22,

Kamper teaches wherein the display unit is configured to display additional information without altering a file corresponding to the image on the display unit (see col. 3, lines 38-43, kamper).

As to claim 23,

Kamper teaches wherein the display unit is configured to display a pop-up menu prepared based on the search result (see col. 3, lines 38-43, kamper).

As to claim 24,

Kamper teaches wherein the identification unit is configured to identify a non-linked word (see col. 3, lines 38-43, kamper).

As to claim 25,

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Kamper teaches when a file comprising a hypertext file or a non-hypertext file is displayed on the display unit, the identification unit is configured to identify a word from the file as the keyword specified by the cursor (col. 10, lines 3-4) on the display unit (see col. 3, lines 38-43, kamper).

As to claim 26,

Kamper teaches a search criteria specification unit configured to display, on the display unit, in a space adjacent to the keyword, a menu for specifying search criteria for the search unit, the menu comprising menu items to be specified by a (see col. 3, lines 38-43, kamper); and

a transfer unit configured to transfer the keyword and the menu items specified to the search unit (see col. 3, lines 38-43, kamper).

As to claim 27,

Kamper teaches wherein the menu is for specifying at least one search database (see col. 3, lines 16-23, Kamper).

As to claim 28,

Kamper teaches an output criteria specification unit configured to display, on the display unit, in a space adjacent to the keyword, a menu for specifying output criteria of the search result (see col. 3, lines 38-43, kamper).

As to claim 29,

Kamper teaches wherein the menu is for specifying where to output the result of the search (see col. 3, lines 16-23, Kamper).

With respect to claim 30,

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Kamper discloses an information management device (see Abstract, lines 4-9), comprising:

- means for displaying an image (see col. 3, lines 16-23, Kamper);
- means for identifying a word displayed in the image to be a keyword (see col. 3, lines 16-23, Kamper);
- means for determining a search result corresponding to the keyword (see col. 3, lines 35-43, Kamper);
- means for displaying information corresponding to the search result (see col. 3, lines 42-43, Kamper); and
- means for displaying additional information corresponding to a selection of a portion of the displayed information (see col. 3, lines 34-37).

Kamper does not explicitly indicate the claimed "word displayed in an image".

Evans discloses the claimed word displayed in an image (Hyperlinks operate on a page image shown to a database user. A phrase or text section on the page image will be highlighted. When a user selects this phrase clicking on the mouse, the user immediately shown the related text from another document, see col. 1, lines 39-43, Evans).

It would have been obvious to one ordinary skill in the data processing art, at the time of the present invention to have combined the teachings of the cited references because word displayed in an image of Evans's teachings would have allowed Kamper's system to select a phrase or text from the page image by clicking with a mouse will be able immediately shown related text from another

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document as suggested by Evans, see col. 1, lines 39-43). Word displayed in an image as taught by Evans improves to display portions of text from multiple documents over multiple databases related to a search query (see col. 2, lines 36-37 et seq, Evans).

With respect to claim 31,

Kamper discloses a computer program product storing program instructions for execution on a computer device, which when executed by the computer device, cause the computer device to perform (see Abstract, lines 4-9) the steps of:

identifying a word displayed in an image to be a keyword (see col. 3, lines 16-23, Kamper);

determining a search result corresponding to the keyword (see col. 3, lines 35-43, Kamper);

displaying information corresponding to the search result (see col. 3, lines 42-43, Kamper); and

displaying additional information corresponding to a selection of a portion of the displayed information (see col. 3, lines 34-37).

Kamper does not explicitly indicate the claimed "keyword displayed image".

Evans discloses the claimed keyword displayed image (Hyperlinks operate on a page image shown to a database user. A phrase or text section on the page image will be highlighted. When a user selects this phrase clicking on

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the mouse, the user immediately shown the related text from another document, see col. 1, lines 39-43, Evans).

It would have been obvious to one ordinary skill in the data processing art, at the time of the present invention to have combined the teachings of the cited references because keyword displayed image of Evans's teachings would have allowed Kamper's system to select a phrase or text from the page image by clicking with a mouse will be able immediately shown related text from another document as suggested by Evans, see col. 1, lines 39-43). Keyword displayed image as taught by Evans improves to display portions of text from multiple documents over multiple databases related to a search query (see col. 2, lines 36-37 et seq, Evans).

Contact Information

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad Ali whose telephone number is (571) 272-4105 . The examiner can normally be reached on Monday to Thursday from 7:30am-6:00pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306 for any communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.

MA

November 3, 2004



Mohammad Ali

Primary Patent Examiner

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